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10/722,840	11/25/2003	T. Clare Huang	42053.86USPT	8196

7590 09/28/2004

Shell Oil Company  
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EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/722,840

Applicant(s)

HUANG ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 to 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Art Unit: 1712

1. Regarding claims 3, 11, 25 and 33, the phrases "such as" and "preferably" render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

2. Claims 9 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by "hydrophobic solids (polyurea)".

3. For the record please note that, while applicants refer to their composition as a tire dressing composition, this is a future intended use limitation. The composition is fully defined by the component therein and as such this phrase carries no patentable weight.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 to 9, 12 to 15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Klayder et al.

Klayder teaches silicone gels. Particular attention is drawn to Example 2. This contains a silicone microemulsion and a polyalkylene oxide modified silicone surfactant (the bottom of column 4 defines Silwet 7606). This meets the requirements of claim 1,

Art Unit: 1712

since instant claim 7 reflects the fact that polyalkylene oxide modified silicone surfactant meets the claimed wetting agent. The silicone microemulsion meets the requirements of claims 2 to 4 (note that the silicone fluid in claim 4 does not exclude amine functional groups from the silicone fluid, it only requires that the silicone fluid have functionalities other than the amine functionality, and the methyl functional groups on the prior art silicone meet this limitation). The surfactant in Example 2 also meets the requirements of claims 5, 8 and 9. This example contains triethanolamine, meeting claims 12 and 13, as well as propylene glycol, meeting claims 14 and 15. In this manner the claims are anticipated by the prior art.

7. Claims 16, 17, 21 to 31 and 35 to 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klayder et al.

With regards to claims 16 and 17, the skilled artisan would have expected the composition of Klayder et al. to be packaged in a conventional bottle. The selection of conventional plastic bottles for packaging the composition of Klayder et al., such as PVC and PET, would have been well within the skill of the ordinary artisan.

With regards to claim 21, patentees teach on line 15 of column 6 that colorants can be added to the treating composition of Klayder et al. One having ordinary skill in the art would have been motivated to add conventional colorants such as pigments and glitter particles to the treating composition of Klayder et al. in an effort to obtain the known benefits and properties therewith, and in an effort to produce a treating agent that will have consumer appeal.

With regards to claim 22, the Examiner notes that patentees do not specifically teach coating a tire with this composition; however, column 1, line 26, teaches treating rubbers and this composition is used to polish and/or protect automobiles. As such the skilled artisan would have found it obvious and within routine experimentation to use this composition to treat tires, thereby rendering this method obvious. The limitations of claims 23 to 31 and 35 to 37 are composition limitations comparable to those addressed in paragraph 6, *supra*.

Art Unit: 1712

8. Claims 1 to 6, 10, 11, 14, 15, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Merrifield et al.

As noted supra, the prior art need not teach a tire dressing composition to anticipate the claims. Merrifield et al. teach amine functional microemulsions. As can be seen from the bottom of column 1 through column 2, the composition contains an amino functional silicone and a surfactant. This meets instant claim 1 as the surfactants therein can be considered wetting agents. See for instance Table 1. Consistent with that noted in paragraph 6, supra, the aminofunctional siloxane meets the requirements of claim 4, since it contains methyl functional groups. Column 7, lines 19 to 24, teaches that the composition can be in a aerosol container and contain propellants, meeting claims 10, 11, 18 and 19. Column 6, lines 26 to 28, teaches the limitation of claims 14 and 15. In this manner these claims are anticipated by the prior art.

9. Claims 7 to 9, 16, 17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrifield et al.

Regarding claims 7 to 9, note column 4, lines 35 to 38, which teaches the addition of polyether silicone surfactants. As such one having ordinary skill in the art would have been motivated to include a compound meeting the limitations of these claims in the composition of Merrifield et al.

Regarding claims 16 and 17, the Examiner relies on the same rationale as detailed in paragraph 7, supra. Also note that the top of column 7 teaches various uses for this composition such as shampoos and conditioners, which commonly use PET and PVC plastic bottles for packaging.

With regard to claim 20, note that the personal care compositions taught by Merrifield on the top of column 7 are often in gel form, such as hair styling gels, sunscreens and antiperspirants. Thus it would have been obvious for the skilled artisan to prepare the composition of Merrifield in the form of a gel.

Finally, regarding claim 21, note that many of the personal care compositions taught by Merrifield on the top of column 7 often contain pigments and glitter, such as blushes, lipsticks and eye-shadows. As such one having ordinary skill in the art would

Art Unit: 1712

have been motivated to include such components in the composition of Merrifield et al., thereby rendering these claims obvious.

10. Claims 1 to 10, 12, 14, 15, 18, 19, 22 to 32, 34, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Estes.

Estes teaches rubber and vinyl protectant used to treat tires. See the top of column 1. This composition contains a siloxane microemulsion. See for instance the top of column 2 as well as the working examples. Lines 25 to 35 of column 2 teaches that the siloxane can be amino functional silicone or a silicone having other functionalities. The silicone is used in combination with a surfactant, thus meeting the requirements of claims 1 to 6.

Particular attention is drawn to lines 33 to 35, which teach that the silicone can be glycol copolymers. These are polyether modified siloxanes. The Examiner notes that the wetting agent in claim 1 can be part of the silicone microemulsion. Thus when glycol siloxane copolymers are used to form the silicone microemulsion the composition will have each component necessary to meet claims 7 to 9 as well. That is, the same silicone used to form the silicone microemulsion can meet the requirement of the anti-foaming agent and wetting agent.

With regards to claims 18 and 19, note the teachings on column 6, lines 48 to 55. This teaches that the composition is a sprayable product and can be contained in an aerosol container. It necessarily follows that such a composition will inherently contain a propellant; otherwise, the product would not be usable. In this manner the limitation of claim 10 is anticipated by Estes.

The components in claims 12, 14 and 15 are found on column 6, lines 59 to 63.

As noted supra, Estes uses this composition to treat tires. In this manner claim 22 is anticipated as well. With regards to claims 23 to 32, 34, 36 and 37, these composition limitations are found in Estes, as noted supra.

11. Claims 11, 16, 17, 21 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes.

Patentees fail to specifically teach a propellant. As such one having ordinary skill in the art would have been motivated to select conventional propellants. In addition, for consumer safety, the skilled artisan would have been motivated to select a non flammable propellant. As such the limitations of claims 11 and 33 are rendered obvious.

The Examiner relies on the rationale of record with regards to the obviousness of claims 16 and 17. Note too that column 6, line 50, teaches containers having a pump or trigger spray, which the skilled artisan would realize are conventionally prepared from plastics.

With regards to claim 21, note that column 6 teaches the addition of dye or coloring agents. As such it would have been within routine experimentation and/or optimization for the skilled artisan to add pigments and glitter particles to the composition of Estes, particularly in an effort to heighten consumer appeal.

12. Claims 13 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes as applied to claims 1, 12, 22 and 34 above, further in view of Zhou et al.

Estes fails to specifically teach a corrosion inhibitor. Zhou et al., column 10, lines 1 to 20, teach various known corrosion inhibitors and indicates that triethanolamine is a commercially available corrosion inhibitor. One having ordinary skill in the art, upon reading the teaching in Estes that corrosion inhibitors can be present, would have been motivated to select an inhibitor that is commercially available, thereby rendering obvious the selection of triethanolamine and the limitation of claims 13 and 35.

13. For the record the Examiner notes that many other references either teach and/or suggest the instant claims. She cites some of them in PTO-892. None of the references are believed to be any closer to the instant claims than those cited supra, however, and rejections over each reference have not been made in this stage of prosecution to avoid redundancy. Ohara et al. teach a spray lustering-cleansing agent containing a silicone emulsion. Berthiaume et al. (both references) teach silicone micro-emulsions. Schmeida et al. teach a silicone emulsion for vehicle cleaning. Parkinson et

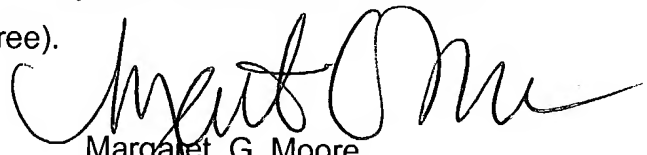
Art Unit: 1712

al. teach an aminosilicone emulsion used to treat various surfaces. Schultz et al. teach automotive wash and wax composition containing a silicone emulsion. Shinohara et al. teach a cleansing-lustering agent that contains a silicone emulsion and Colurciello teaches cleaning and surface treatment compositions containing a silicone emulsion.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

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9/26/04